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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/520,562

01/07/2005

Karin Golz-Berner

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04/01/2009

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EXAMINER

CHUI, MEI PING

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/520,562 | Applicant(s) GOLZ-BERNER ET AL. | |
| | Examiner MEI-PING CHUI | Art Unit 1616 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/15/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Status of Action

The examiner of record acknowledges the receipt of Application filed on 021/07/2005

Status of Claims

Accordingly, claims **1-5 and 7** are presented for examination on the merits for patentability and claim **6** has been canceled in this application.

Claim Rejections - 35 USC § 112 second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. All dependent claims are included in the rejection. All depended claims are included in the rejection.

Claim 5 recites "the anti-aging skin cosmetic according to claim 1, wherein the cosmetic contains60 % to 80 % by weight water; 0.1 to 1 % by weight of a silicone wax, 0.3 % to 0.7 % by weight of a preservative or preservative mixture.....0.1 % to 0.5 % by weight Benzophenone-4 and optionally 0.1 % to 1 % by weight of colorant and perfume respectively", which is indefinite because it is unclear whether this part of the recitation in claim 5 is further limiting the recitation of claim 1, where it recites the limitation of "an anti-ageing skin cosmetic

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comprising and up to 100 % by weight, other active substances, carrier substances, adjuvants or mixture thereof”, or Applicants are intending to recite additional constituents in this part of the claim 5. Applicants are suggested to include the term “further” in claim 5 to indicate if any additional constituent(s) are intended to be added to the cosmetic composition of claim 1.

Claim Rejections - 35 USC § 103

35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this

Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golz-Berner et al. (CA 2,335,149) in view of Murad, H. (WO 00/64472) and Simon et al. (U.S. Patent No. 6,652,868).

Applicant Claims

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Applicant claims an anti-ageing skin cosmetic composition, and a method of reducing wrinkles and for prolonging the period for a visibly wrinkle-free skin, comprising a mixture of extracts from: fig leaves and fruits, pomegranate fruits, rosemary stems and leaves, liposomes containing extracts from peeled musk melon, plankton and micrococcus lysate, wherein the cosmetic composition also comprises an active formulation containing extracts of Quebracho blanco and silkworm, as well as hydrogel, UV filter benzophenone-4.

***Determination of the scope and content of the prior art
(MPEP 2141.01)***

Golz-Berner et al. teach a cosmetic composition comprising active substances that has a particularly high radical protection potential and can be kept for a long period of time (page 2, lines 15-20). Golz-Berner et al. teach that the active substances have a high radical protection factor, wherein the active substances include a product obtained by extracting the bark of Quebracho blanco and subsequent enzymatic hydrolysis, which product contains at least 90% by weight proanthocyanidine oligomers and up to 10% by weight gallic acid, wherein the content of the active substance (a) has a concentration of 2% by weight linked to a microcapsules, ranging from 0.1 and 10% by weight; (b) a silkworm extract obtained by extraction, which extract contains the cecropine peptide, amino acids and a vitamin mixture, wherein the content of (b) ranging between 0.1 and 10% by weight; (c) a non-ionic, cationic or anionic hydro-gel or hydrogel mixture, wherein the content of (c) ranging between 0.1 and 5% by weight (page 2, lines 29 through page 3, line 11).

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Golz-Berner et al. also teach that the components (a) and (b) of the active substance in the composition and the phospholipids (d) presumably form association-like configurations of different molecules which again are accumulated mostly homogeneously in the generating structure of the gel (c) and (e), the whole being called “association complex” (see page 5, lines 29-36):

Golz-Berner et al. further teach that the composition also comprises a mixture of liposomal *Micrococcus luteus* extract prepared with phospholipids in 0.1 % by weight and phospholipids, which is presented in 0.2 % to 5 % by weight. Golz-Berner et al. teach that the phospholipids contain phosphatidyl choline, phosphatidyl ethanolamine (page 5, lines 22-24). Golz-Berner et al. teach then that water as the remaining portion up to 100 % by weight along with other auxiliary or carrier substances (page 3, lines 21-25 and page 3-5).

Furthermore, Golz-Berner et al. teach the cosmetic composition comprises plant extracts such as citric peel, fruit or leaves extract, which can present in 0.5 % to 20 % by weight; fruit extract, which can present up to 20 % by weight; plankton extract obtained from algae, which can bind to free radicals or moisture and can be present in an amount from 0.5 % to 20 % by weight; ; alcohol, waxes, UV filters, i.e. benzophenone derivatives, emulsifiers, i.e. glycerin, polyglucosides such as cellulose. More specifically, Golz-Berner et al. teach carbomer present in 0.2 %, glycerin present in 2.0 %, triethanolamine present in 0.2 %, perfume present in 0.5 %, preserving agent present in 0.3 %, by weight, and water adjusted to 100 % by weight (page 6, lines 14-17, 39-41; page 8, lines 34-36; page 10, lines 13-32 and page 12, lines 20-25).

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Golz-Berner et al. teach a cosmetic composition containing active substances, i.e. extracts, i.e. plankton extract, citric extracts, Quebracho blanco extract, silkworm extract and *Micrococcus luteus* extracts, from various sources and types that can be delivered to the skin using phospholipids containing-liposomal as carrier. Golz-Berner et al. also teach that the cosmetic composition provides a particularly high radical protection potential and can be staying on the skin over a long period of time. However, Golz-Berner et al. do not specifically teach the extracts from pomegranate, rosemary and fig, as well as peeled musk melons.

The deficiency is cured by Murad, H. and Simon et al. in combination.

Murad, H. teaches a method and a composition for treating dermatological conditions, i.e. skin wrinkle or UV damage caused by exposure to UV light. Murad, H. teaches that the composition comprises one or more fruit extracts contain antioxidants, i.e. pomegranate, in an amount sufficient to neutralize free radicals, and pharmaceutical acceptable carrier (page 8, lines 27-30), wherein the composition also comprises additional extracts, i.e. rosemary extract, to facilitate managing the dermatological conditions. Murad, H. teaches that the fruit extracts can be presented in an amount from about 0.01 % to 80 % by weight, preferably 0.5 % to 10 % by weight. In addition, Murad, H. teach that any fruit extracts capable of preventing, treating or managing skin disorders and/or skin damage is suitable for use in the composition and the method (page 9, line 14 and page 11, lines 14-25).

Murad, H. further teaches that the composition includes additives, i.e. UV filter benzophenone-4 (0.01 % - 5 %), EDTA (0.01 % to 5 %), butylene glycol (0.5 % to 6 %), acceptable carriers, i.e. guar gum or ethyl cellulose (see Examples).

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Simon et al. teach a composition comprising vegetable derived elements for improving the constitution of the skin tint, smoothing the skin surface, removing wrinkle, blemishes, wherein the vegetable derived element can be carried out by directly rubbing the skin areas to be treated with this element. Simon et al. teach that the vegetable derived element is obtained from the hair of *figus carica* leaves (Abstract and column 5, lines 30-33). It is noted that *figus carica* is also commonly known as fig.

***Finding of prima facie obviousness Rational and Motivation
(MPEP 2142-2143)***

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Golz-Berner et al. with Murad, H. and Simon et al. to arrive at the instant invention.

One of ordinary skill would have been motivated to incorporate other fruit extracts, i.e. pomegranate and peeled musk melon extracts, into a cosmetic composition that contains extracts of active substances, as taught by Golz-Berner et al., because fruit extracts, i.e. pomegranate, are rich in antioxidants that can help to neutralize free radicals, and, thus, is capable of preventing, treating or managing skin conditions, i.e. skin wrinkle, or skin damage cause by UV exposure. One ordinary also would have been motivated to include additional extracts, i.e. rosemary or fig extracts, because they can help to facilitate managing the skin conditions, as well as improving the constitution of the skin tint, smoothing the skin surface, removing wrinkle and blemishes, as taught by Murad, H. and Simon et al.

With regard to the amount of the extracts or the customary adjuvants, i.e. xanthum gum, is merely judicious selection and routine optimization, and would have been obvious to a person

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of ordinary skill in the art to try different amount and adjuvants, and select the desirable amount and adjuvant dependent on the desired product one wishes to attain. .

From the teaching of the references, one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Conclusion

No claims are allowed.

Contact Information

Any inquiry concerning this communication from the Examiner should direct to Helen Mei-Ping Chui whose telephone number is 571-272-9078. The examiner can normally be reached on Monday-Thursday (7:30 am – 5:00 pm). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either PRIVATE PAIR or PUBLIC PAIR. Status information for

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unpublished applications is available through PRIVATE PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the PRIVATE PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Johann R. Richter/

Supervisory Patent Examiner, Art Unit 1616